



DOCKET No.: 2300.0202

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue application of:

Graeme I. Bell, et al.  
U.S. Patent No. 5,405,942  
Issued: April 11, 1995

Serial No.: unassigned

Group Art Unit: 1804

Filed: herewith

Examiner: J. Stone

For: PREPRO INSULIN-LIKE  
GROWTH FACTORS I AND II

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Dear Sir:

DECLARATION AND POWER OF ATTORNEY  
IN APPLICATION FOR REISSUE OF  
BELL ET AL. U.S. PATENT No. 5,405,942

In accordance with the provisions of 35 USC §251 and 37 CFR §1.172(a), Graeme I. Bell, Leslie B. Rall and James P. Merryweather (whose citizenship, residence and post office address are set forth below), named as the original, first and joint inventors of the invention described and claimed in U.S. Patent No. 5,405,942 ("the original patent"), filed as Serial No. 07/065,673, on June 16, 1987, and granted on April 11, 1995, hereby apply for and assent to reissue of said patent and declare as follows:

1. We have reviewed and understood the entire specification and claims of the attached reissue application, and the accompanying Preliminary Amendment and we believe that we are the original, first and joint inventors of the subject matter

which is claimed and for which a reissue of said patent is being sought.

2. The duty to disclose to the Office all information known to said assignee and said inventors to be material to patentability as defined in 37 CFR §1.56 is hereby acknowledged.

3. It is verily believed that said original patent may be partly inoperative under 35 USC §251 for having claimed less than the inventors had a right to claim as explained in detail hereinafter.

4. This reissue application seeks to enlarge the scope of the claims of the original U.S. Patent No. 5,405,942.

5. Said original patent issued with claims 1 through 22 therein. None of those original claims is directed to any method, much less a method of producing a polypeptide, or of expression in a transformed host cell. The failure to claim such a method is an insufficiency of the original claims which is sought to be remedied by this reissue application by the addition of claims 23 through 41 in the accompanying Preliminary Amendment.

6. We have been advised and believe that the statements set forth in the following paragraphs 7-12 are true.

7. Applicants' application Serial No. 07/065,673, filed June 16, 1987, and its parent application Serial No. 06/630,557, filed July 13, 1984, never contained any type of method or process claims.

8. As seen from the foregoing, no method claims of the type now being sought were presented in Serial No. 07/065,673, at the time of filing on June 16, 1987, or during its pendency prior to issue of the original patent on April 11, 1995. It was error without deceptive intent on the part of applicants and assignee, that arose during that time period, to fail to present such method claims and to permit its original U.S. Patent No. 5,405,942 to issue without such claims.

9. The error described in paragraph 8 above was discovered by the assignee in the October-November 1996 period when the subject patent was evaluated for its potential exclusionary scope. At that time, it was noted that the absence of method or process claims in the subject patent would prevent the assignee from availing itself of the provisions of 35 USC §271(g) as to imports made abroad by a patented method or process. However, it was not then known for certain whether or not there were likely to be such imports for which exclusion was necessary.

10. Shortly after said error was discovered, assignee asked its attorneys in November 1996 to evaluate the patent to determine whether the error was correctable by filing a reissue to include the appropriate method claims therein. After thorough study and consultation, its attorneys advised that the error should be correctable by reissue.

11. After learning that the error should be correctable, and in view of the fact that the existing claims in the original patent were not adversely affected by the error, applicants' assignee undertook a study to determine if the error is significant enough to submit the patent to reissue examination to avail itself of the protection of 35 USC §271(g) in view of the potentially infringing activities of others. It was only recently that sufficient facts were learned showing that the error in not having the method claims in the patent is significant enough to merit this application for reissue, and that there may be imports for which protection is needed.

12. After reviewing the matter, we believe that through error and without deceptive intent applicants and assignee failed to recognize the error at the time it was made. We believe that the error is one correctable by filing the instant reissue application at this time with the newly added method claims 23-41 being added by the accompanying Preliminary Amendment in accordance with MPEP §1453.

13. Applicants declare that they have read and understood claims 1-22 of their original patent, and have read and understood claims 23-41 of said Preliminary Amendment and the Remarks made therein; applicants believe that they are the original, first and joint inventors of the invention claimed in claims 1-41 and which is described in their original patent.

13. Applicants and the assignee hereby offer to surrender the original U.S. Patent No. 5,405,942 in accordance with 37 CFR §1.178.

POWER OF ATTORNEY

Applicants hereby appoint Robert P. Blackburn, (Registration No. 30,447), Barbara G. McClung (Registration No. 33,113), Joseph A. Guth (Registration No. 31,261), Francis A. Paintin (Registration No. 19,386), Dianne B. Elderkin (Registration No. 28,598), Doreen Y. Trujillo (Registration No. 35,719), as its attorneys with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent and Trademark Office connected therewith.

Send all future correspondence and address all  
telephone calls to:

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DECLARATION

We, the undersigned, hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued hereon.

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Execution by Inventors:

Signed: \_\_\_\_\_ Date: \_\_\_\_\_  
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